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In re Application of :
DIEFENBACHER et al. :
Application No.: 10/598,639 : DECISION
PCT No.: PCT/EP2005/051057 :
Int. Filing Date: 09 March 2005 :
Priority Date: 10 March 2004 :
Attorney Docket No.: 5880 :
For: METHOD AND SCANNING ARRANGEMENT :
FOR THE CONTACTLESS SCANNING OF THREE- :
DIMENSIONAL OBJECTS AND DEVICE FOR :
HOLDING THE OBJECTS :
:

This decision is in response to applicant's petition under 37 CFR 1.137(b) filed 02 September 2009 in the United States Patent and Trademark Office (USPTO).

BACKGROUND

On 09 March 2005, applicants filed international application PCT/EP2005/051057, which designated the United States and claimed a priority date of 10 March 2004. A copy of the international application was communicated from the International Bureau to the USPTO on 22 September 2005. The thirty-month period for paying the basic national fee in the United States expired at midnight on 11 September 2006 (10 September 2006 being a Sunday).

On 07 September 2006, applicants filed a submission for entry into the national stage in the United States which was accompanied by, *inter alia*, the U.S. Basic National Fee.

On 26 April 2007, the United States Designated/Elected Office (DO/EO/US) mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating, *inter alia*, that an oath or declaration of the inventors in compliance with 37 CFR 1.497(a)-(b) and the surcharge under 37 CFR 1.492(h) were required. The NOTIFICATION set a two-month extendable period for response.

On 13 September 2007, applicants filed a response including a declaration of inventors, the surcharge under 37 CFR 1.492(h), and a petition/fee for a three month extension of time.

On 26 October 2007, the DO/EO/US mailed a NOTIFICATION OF DEFECTIVE RESPONSE (Form PCT/DO/EO/916) indicating, *inter alia*, that the declaration submitted 13 September 2007 was not in compliance with 37 CFR 1.497(a)-(b) because it did not indicate the inventor Dean Stoops.

On 26 November 2007, applicants filed a submission which included, *inter alia*, a petition under 37 CFR 1.47(a).

On 25 June 2007, a decision was mailed dismissing without prejudice applicants' petition under 37 CFR 1.47(a) for failing to provide factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort. The decision also noted that the declaration of inventors filed 13 September 2007 was not sufficient because it did not identify all of the inventors.

On 13 February 2008, applicants filed a renewed petition under 37 CFR 1.47(a) which was accompanied by a declaration of inventors signed by previously non-signing inventor Rolf Diefenbacher.

On 17 March 2008, a decision was mailed dismissing as moot applicants' petition under 37 CFR 1.47(a) because a 37 CFR 1.497 declaration has been executed by all the joint inventors. The decision also indicated that the declarations of inventors filed 13 September 2007 and 13 February 2008 were not in compliance with 37 CFR 1.497(a)-(b) because each declaration failed to list all of the inventors. The decision set a time limit of ONE MONTH from the date of mailing or within the time remaining in the response set forth in the decision mailed 18 January 2008, whichever is longer, in which to file a proper response.

On 20 February 2009, the DO/EO/US mailed a NOTIFICATION OF ABANDONMENT (Form PCT/DO/EO/909) indicating that the application was abandoned as to the United States of America for failure to properly respond to the decision mailed 17 March 2008.

On 01 May 2009, applicants filed a petition under 37 CFR 1.137(b) which was accompanied by two declarations of inventors.

On 02 July 2009, a decision was mailed dismissing without prejudice applicants' petition under 37 CFR 1.137(b). Specifically, it was noted that the required reply of a declaration in compliance with 37 CFR 1.497(a)-(b) had not been satisfied.

On 02 September 2009, applicants filed the instant petition under 37 CFR 1.137(b) which was accompanied by a declaration of inventors.

DISCUSSION

A petition to revive the present application under 37 CFR 1.137(b) must include:

- (1) The required reply;
- (2) The petition fee;
- (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional.

Item (1) has now been satisfied. The declaration of inventors filed 02 September 2009 is in compliance with 37 CFR 1.497(a)-(b).

As to item (2), applicant submitted the petition fee on 01 May 2009.

As to item (3), a grantable petition has not yet been provided.

CONCLUSION

For the reasons set forth above, the petition under 37 CFR 1.137(b) is **DISMISSED** without prejudice.

Applicant is hereby given the time limit of **TWO (2) MONTHS** from the mail date of this communication in order to file a proper response.

Failure to timely file a proper response to this decision in a timely manner will result in abandonment of the application with regards to national stage prosecution in the United States.

Any further correspondence with respect to this matter may be filed electronically via EFS-Web or if mailed should be addressed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

/Daniel Stemmer/

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